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09/855,432	05/14/2001	Sturla Lutnaes	34467-00020	9021

7590 05/21/2004  
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EXAMINER

BEHULU, ALEMAYEHU

ART UNIT	PAPER NUMBER
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2682

6

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/855,432

**Applicant(s)**

LUTNAES, STURLA

**Examiner**

Alemayehu Behulu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. Claim 5 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim 5 not been further treated on the merits.
3. The abstract of the disclosure is objected to because on page 12, line 12 the term "fig. 1" should be deleted. Correction is required. See MPEP § 608.01(b).

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6, 424, 844. Although the conflicting claims are not identical, they are not patentably distinct from each other because with obvious variations wordings they both are related to a personal communicator having a touch screen display with a control means to turn on power of the personal communicator if it is determined that a pressed position is valid.

5. Claims 2, 3, 6-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6, 424, 844 in view of Kurihara (U.S. Patent No. 6, 476, 797).

Regarding claim 2, claim 2 of U.S. Patent No. 6, 424, 844 a portable telephone according to claim 1. However, claim 2 of U.S. Patent No. 6, 424, 844 fails to disclose fails to disclose wherein the control block is arranged to detect whether the touch position lies within an area defined by four co-ordinates or less defining the maximal area of an on-button of the input-means, or whether it lies within any of the areas of two or more on-buttons or within a combined area of adjoining on-buttons. But, Kurihara discloses the control block is arranged to detect whether the touch position lies within an area defined by four co-ordinates or less defining the maximal area of an on-button of the input-means, or whether it lies within any of the areas of two or more on-buttons or within a combined area of adjoining on-buttons (figure 2, numbers 6, column 3, lines 53-column 4, lines 8). Therefore at the time of the invention it would have been

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obvious to a person of ordinary skill in the art to combine claim 2 of U.S. Patent No. 6, 424, 844 (U.S. Patent No. 6, 424, 844) with Kurihara (U.S. Patent No. 6, 476, 797) so that the device will not be turned on mistakenly other than predetermined positions on the screen as suggested by Kurihara.

Regarding claim 3, claim 2 of U.S. Patent No. 6, 424, 844 discloses a portable telephone according to claim 1. However, claim 2 of U.S. Patent No. 6, 424, 844 fails to disclose wherein the control block is arranged to detect whether two sequential touch positions lie within two areas, each defined by four co-ordinates or less defining the maximal area of a corresponding on-button of the input-means. But, Kurihara discloses the control block is arranged to detect whether two sequential touch positions lie within two areas, each defined by four co-ordinates or less defining the maximal area of a corresponding on-button of the input-means (see Kurihara column 4, lines 17-40). Therefore at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine claim 2 of U.S. Patent No. 6, 424, 844 (U.S. Patent No. 6, 424, 844) with Kurihara (U.S. Patent No. 6, 476, 797) thus, the device would be turned on by the user who knows the sequential touch positions, which provides security as suggested by Kurihara.

Regarding claim 6, claim 2 of U.S. Patent No. 6, 424, 844 discloses a method for controlling connection of the power supply means in a portable phone provided with a touch screen display, for powering-on the phone, comprising the steps of: providing user-operable input means, which

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can order a voltage controlled switch connected to said touch screen display to turn on the power of the portable phone; enabling a voltage controlled switch by a signal originating from said power-on key provided on the touch screen display in order to turn on the power of the portable phone, as well as the step of performing an initial detection and evaluation whether it is a valid pressed position on the touch-screen display before powering-on the phone, by means of a control block connected to the voltage controlled switch. However, claim 2 of U.S. Patent No. 6, 424, 844 fails to disclose sensing whether a power-on key of said input means provided on the touch screen display has been depressed by a user of the portable phone. But, Kurihara discloses sensing whether a power-on key of said input means provided on the touch screen display has been depressed by a user of the portable phone (column 4, lines 17-67). Therefore at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine claim 2 of U.S. Patent No. 6, 424, 844 with Kurihara (U.S. Patent No. 6, 476, 797) in order to add security feature to the device as suggested by Kurihara.

Regarding claim 7, the combination of claim 2 of U.S. Patent No. 6, 424, 844 and Kurihara method disclose according to claim 6, comprising the step of detecting whether the touch position lies within an area defined by four co-ordinates or less defining the maximal area of an on-key of the input-means, or whether it lies within any of the areas of two or more on-keys or within a combined area of adjoining on-keys (see Lundqvist figure 1, numbers 70 and 9).

Regarding claim 8, the combination of claim 2 of U.S. Patent No. 6, 424, 844 and Kurihara method according to claim 6, comprising the step of detecting whether two sequential touch

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positions lie within two areas, each defined by four co-ordinates or less defining the maximal area of a corresponding on-key of the input-means (see Kurihara column 4, lines 17-40).

6. Claims 4/1-4/3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6, 424, 844 and Kurihara (U.S. Patent No. 6, 476, 797) in view of Anderison (U.S. Patent No. 5, 790, 875)

Regarding claims 4/1-4/3, the combination of claim 2 of U.S. Patent No. 6, 424, 844 and Kurihara disclose a portable telephone according to claims 1-3. However, the combination of claim 2 of U.S. Patent No. 6, 424, 844 and Kurihara fail to disclose wherein the a wherein the voltage controlled switch comprises control means provided with always-on low frequency (LF) generator means adapted to perform said detection and evaluation. But, Anderison discloses wherein the voltage controlled switch comprises control means provided with always-on low frequency (LF) generator means adapted to perform said detection and evaluation (column 6, lines 4-14). Therefore at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine claim 2 of U.S. Patent No. 6, 424, 844 and Kurihara (U.S. Patent No. 6, 476, 797) with Anderison (U.S. Patent No. 5, 790, 875) in order to save power while the device in not in use and at the same time easy to turn it on when desired.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Lundqvist (U.S. Patent No. 6, 424, 844).

Regarding claim 1, Lundqvist discloses a portable phone (figure 1), such as mobile phone, a cordless phone or a personal communicator, comprising at least one touch screen display (figure 1, number 20) and at least one power supply (figure 2, number 50, column 3, lines 24-36), said touch screen display comprising at least one inner (figure 2, number 30, column 2, lines 36-51, column 3, lines 52-64) and one outer essentially transparent, conducting plate, which are movable in relation to each other between a first position (figure 2, number 40, column 2, lines 36-51, column 3, lines 52-64, column 4, lines 21-24), in which the plates are spaced apart, and a second position, in which the plates are contacted to each other by the outer plate being depressed by a user of the portable phone by means of an input means (column 2, lines 36-51), such as a keypad, or direct activation providing a pressure against the touch screen display, wherein a voltage controlled switch connected to said plates is adapted to turn on the power of the portable phone upon receipt of a signal indicating that a power-on key or a power-on area has



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been depressed by the user (figure 2, number 40, column 2, lines 36-51, column 3, lines 52-64, column 3, lines 18-23), wherein a control block connected to the voltage controlled switch is arranged to perform an initial detection and evaluation whether it is a valid pressed position on the touch-screen display before powering-on the phone (figure 1, number 20, column 3, lines 18-23, column 4, lines 11-18).

Regarding claim 2, Lundqvist discloses a portable telephone according to claim 1, wherein the control block is arranged to detect whether the touch position lies within an area defined by four co-ordinates or less defining the maximal area of an on-button of the input-means, or whether it lies within any of the areas of two or more on-buttons or within a combined area of adjoining on-buttons (figure 1, number 9, 70, column 4, lines 11-18).

9. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Lee (U.S. Patent No. 6, 091, 031).

Regarding claim 6, Lee discloses a method for controlling connection of the power supply means in a portable phone provided with a touch screen display, for powering-on the phone (column 1, lines 24-33, column 3, lines 44-54), comprising the steps of: providing user-operable input means, which can order a voltage controlled switch connected to said touch screen display to turn on the power of the portable phone (column 3, lines 19-52); sensing whether a power-on key of said input means provided on the touch screen display has been depressed by a user of the

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portable phone (column 4, lines 12-53); enabling a voltage controlled switch by a signal originating from said power-on key provided on the touch screen display in order to turn on the power of the portable phone (figures 4A, 4B, numbers 6-1, 6-2, 6-3, 6-4), as well as the step of performing an initial detection and evaluation whether it is a valid pressed position on the touch-screen display before powering-on the phone, by means of a control block connected to the voltage controlled switch (figure 1, number 6, column 3, lines 19-column 4, lines 11).

Regarding claim 7, Lee discloses a method according to claim 6, comprising the step of detecting whether the touch position lies within an area defined by four co-ordinates or less defining the maximal area of an on-key of the input-means, or whether it lies within any of the areas of two or more on-keys or within a combined area of adjoining on-keys (column 1, lines 47-54, figure 1 and figure 2B, number 6, figure 2A, numbers 6-1 to 6-4).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 3, 4/1-4/3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderison (U.S. Patent No. 5, 790, 875) in view of Kurihara (U.S. Patent No. 6, 476, 797).

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Regarding claim1, Anderison discloses a portable phone, such as mobile phone, a cordless phone or a personal Communicator (column 2, lines 7-11), comprising at least one touch screen display (figure 4, number 41) and at least one power supply (figure 3, label VDD, column 1, lines 59-column 2, lines 6), said touch screen display comprising at least one inner and one outer essentially transparent, conducting plate (figure 3, numbers 31, 32), which are movable in relation to each other between a first position, in which the plates are spaced apart, and a second position, in which the plates are contacted to each other by the outer plate being depressed by a user of the portable phone by means of an input means, such as a keypad, or direct activation providing a pressure against the touch screen display (column 2, lines 29-43, column 3, lines 40-61, column 4, lines 31-65) wherein a voltage controlled switch connected to said plates is adapted to turn on the power of the portable phone upon receipt of a signal indicating that a power-on key or a power-on area has been depressed by the user (column 1, lines 66-column 2, lines 1-6 and 44-54, column 3, lines 46-61, column 6, lines 15-23). However, Anderison fails to disclose wherein a control block connected to the voltage controlled switch is arranged to perform an initial detection and evaluation whether it is a valid pressed position on the touch-screen display before powering-on the phone. But, Kurihara discloses a control block connected to the voltage controlled switch is arranged to perform an initial detection and evaluation whether it is a valid pressed position on the touch-screen display before powering-on the phone (figure 1, number 6, column 3, lines 19-column 4, lines 11). Therefore at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Anderison (U.S. Patent No. 5, 790, 875) with Lee (U.S. Patent No. 6, 091, 031) thus, the controller may not mistakenly turn on the device.

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Regarding claim 2, the combination of Anderison and Kurihara disclose a portable telephone according to claim 1, wherein the control block is arranged to detect whether the touch position lies within an area defined by four co-ordinates or less defining the maximal area of an on-button of the input-means (see Anderison figure 3, labels X, X1, Y and Y2, column 4, lines 32-65), or whether it lies within any of the areas of two or more on-buttons or within a combined area of adjoining on-buttons (see Kurihara column 1, lines 47-54, figure 1 and figure 2B, number 6, figure 2A, numbers 6-1 to 6-4).

Regarding claim 3, the combination of Anderison and Lee disclose a portable telephone according to claim 1, wherein the control block is arranged to detect whether two sequential touch position s lie within two areas, each defined by four co-ordinates or less defining the maximal area of a corresponding on-button of the input-means (see Kurihara column 4, lines 17-40).

Regarding claims 4/1-4/3, the combination of Anderison and Lee disclose a portable telephone according to claims 1-3, wherein the a portable telephone according to anyone of the preceding claims, wherein the voltage controlled switch comprises control means provided with always-on low frequency (LF) generator means adapted to perform said detection and evaluation (see Anderison column 6, lines 4-14).

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Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Patent No. 6, 091, 031) in view of Kurihara (U.S. Patent No. 6, 476, 797).

Regarding claim 8, Lee discloses a method according to claim 6. However, Lee fails to disclose the step of detecting whether two sequential touch positions lie within two areas, each defined by four co-ordinates or less defining the maximal area of a corresponding on-key of the input-means. But, Kurihara discloses the step of detecting whether two sequential touch positions lie within two areas, each defined by four co-ordinates or less defining the maximal area of a corresponding on-key of the input-means (column 4, lines 17-40). Therefore at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Lee (U.S. Patent No. 6, 091, 031) with Kurihara (U.S. Patent No. 6, 476, 797) thus, the device would be turned on by the user who knows the sequential touch positions, which provides security as suggested by Kurihara.

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*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Koziuk et al. (U.S. Patent No. 6, 058, 485) Method and Apparatus for Managing Power Consumption of a Digitizing Panel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alemayehu Behulu whose telephone number is 703-305-4828.

The examiner can normally be reached on 8 AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB

  
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5/14/04